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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Teresa MUJICA-FERNAUD et al.

Examiner: OWENS, Amelia A.

Serial No.: 10/725,349

Group Art Unit: 1625

Filed: December 2, 2003

Title: 2-BENZOYLCHROMONE DERIVATIVES

PETITION FOR WITHDRAWAL OF RESTRICTION REQUIREMENT TO THE DIRECTION UNDER 37 CFR 1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request the reconsideration and withdrawal of the restriction requirement in this petition under 37 CFR 1.181.

In the Office Action dated March 7, 2005, a restriction requirement was made.

Applicants made an election with traverse on March 23, 2005. In the Office Action dated April 21, 2005, the restriction requirement was made final. Applicants requested reconsideration of the restriction requirement in the Reply filed on July 21, 2005. In the Office Action dated October 27, 2005, the restriction requirement was nevertheless maintained. Claims 22-25 and 28-32 are withdrawn.

Applicants submit that it would not pose an undue burden on the PTO to search the withdrawn claims.

For example, withdrawn claims 22, 23, 28, 29, 31 and 32 are directed to products comprising the compound of allowed claim 1 of group I, which claims should readily be also allowed. Products comprising a patentable compound should be readily patentable as well for at least the same reason as the compound was found patentable. No further or maybe only a minimal search effort would be necessary to allow these product claims.

Furthermore, the products of the above-identified claims are combinations of the

compound of claim 1 and other components. As such, it is respectfully submitted that the compound of claim 1 and other components are related as subcombination-combination. Since they are related as combination-subcombination, the standard for requiring restriction herein is not met. M.P.E.P. §806.05(c) states that

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary , i.e. separate classification, status, or field of search. See MPEP §808.02. If it can be shown that a combination, as claimed

- (1) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and
- (2) the subcombination can be shown to have utility either by itself or in other and different relations, the inventions are distinct. When these factors cannot be shown, such inventions are not distinct.

It is submitted that the first requirement for two-way distinctness is not established herein. The combination does require the particulars of the subcombination. All the products of the above-identified claims require the presence of the allowed compound of claim 1. The combination claims are dependent upon the subcombination-compound claims and the subcombination-compounds are an essential distinguishing feature of the combination-compositions.

It is respectfully submitted that when the relationship between the claims are properly characterized, there is no basis for restriction of these claims. Thus, the restriction requirement should be withdrawn over these claims.

The same is true with respect to withdrawn claims 24 and 25 (in the concurrently filed Reply, these claims are made dependent on claim 11, which is noted allowable), which are directed to the allowable method of claim 11 and further comprise administering an additional compound (claim 24) or performing radiotherapy (claim 25). Once claim 11 is examined and noted allowable, one administering a further compound in addition to the compound administered in claim 11 or one performing radiotherapy in addition to the compound administered in claim 11 would necessarily practice the method of examined and allowable claim 11. Thus, the methods of claims 24 and 25 should be also allowable for at least the same reason as claim 11. Thus, no further or maybe only a minimal search would be necessary to readily

allow claims 24 and 25.

With respect to claim 30, directed to a method of using a composition of claim 29, whose withdrawal should be revoked for the reasons discussed above and allowed, MPEP § 821.04, Rejoinder, states that “if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims [both process of making and using] which either depend from or include all the limitations of the allowable product will be rejoined.” Accordingly, since claim 30 directed to a method of using a composition of a claim that is improperly withdrawn, rejoinder of claim 30 is respectfully requested in accord with the rejoinder provisions of the MPEP.

Reconsideration and withdrawal of the restriction requirement and/or rejoinder of claims is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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